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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,990	02/20/2002	Buddy D. Ratner	920010.40001	1736

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EXAMINER

PADGETT, MARIANNE L

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 06/12/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,990

Applicant(s)

Retner et al

Examiner

M.L. Palytt

Group Art Unit

1762

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-85 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-85 are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-41, drawn to a plasma apparatus for depositing ionized molecules, possibly remotely produced, classified in Class 118, subclass 723R+ or 723FI or 723MW or 723E.

II. Claims 42-73, 75-81 and 84-85, drawn to a plasma pre- or post-treatment method and ionized molecule deposition (possibly remotely produced), classified in Class 427, subclass 535.

III. Claims 74 and 82-83, drawn to a medical device or a coated object of any material, classified in Class 428, subclass 411.1+.

2. Claims 1-2, 4-22, 42-43, 46-73, 75-81 and 84-85 are generic to a plurality of disclosed patentably distinct species A comprising: (i) electrospray; (ii) APCI; (iii) FAB; (iv) LSIMS; and (v) MALDI. Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species, even though this requirement is traversed.

Claims 1-4, 8-69, 73-82 and 84-85 are generic to a plurality of disclosed patentably distinct species B comprising biomolecules that are: (i) sugars, which include hyaluronic acid (claims 67, 71-72 and 83); and (ii) enzymes (claims 5 and 70).

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Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

Applicant should pick one species from the species A grouping and one species from the species B grouping (species claim numbers are provided for exemplary convenience only).

3. The inventions are distinct, each from the other because of the following reasons:

Inventions Group II and Group I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used for different processes, because the reagents and precursors used in the apparatus are not part of that apparatus, such that deposition can be of ionized atoms instead of the claimed molecules which are a method limitation not structurally limiting to the apparatus.

4. Inventions Group II and Group III are related as process of making and product made. The inventions are distinct

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if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product may be made by many different processes, considering that the product has no particular structure or material, thus need not involve plasma processes nor claimed apparatus to arrive at that structure. Alternately, when hyaluronic acid is claimed, other coating techniques such as CVD or solution chemistry may be used for the application to procure the same structure.

5. Inventions Group I and Group III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case, as discussed in the preceding paragraph, no particular structure of the product requires use of plasma apparatus, nor are the materials of the substrate nor the coating applied thereon part of the apparatus or required to be used therein.

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6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II or III, or vice versa, restriction for examination purposes as indicated is proper.

7. A telephone call was made to Timothy Boller on 6/3/03 to request an oral election to the above restriction requirement, but did not result in an election being made. As no election was received by close of business on 6/11/03, this restriction requirement is being mailed.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least

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one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Any inquiry concerning this communication should be directed to M. L. Padgett from Monday through Friday from about 8 A.M. to 4:30 P.M. at telephone number (703) 308-2336 and FAX #703 872-9310 (official), 872-9311 (official after final) and 305-6078 (unofficial).

MLPadgett:cdc 6/10/03

June 12, 2003



MARIANNE PADGETT
PRIMARY EXAMINER